

Remarks

Applicants provide the present amendment in connection with a Request for Continued Examination in an effort to more particularly point out the invention. Reconsideration and allowance of the subject application, in view of the following remarks, are respectfully requested.

Claim Amendments

Independent claims 1, 9 and 23 have been generally amended to now recite that the latch lever is pivotally mounted to a base plate by a pin. Support for these amendments may be found through out the specification, e.g. in FIGS 1 and 2 as well as paragraph [0022] of the published application which states, *inter alia*:

Turning to FIG. 1, an exemplary pawl actuator 10 consistent with the present invention is shown in an exploded view. The illustrated actuator generally includes a base plate 12 having a solenoid 14 and latching lever 16 mounted thereon. The latching lever 16 may be pivotally mounted to the base plate 12 by a pin 18, and adapted to follow a detent bracket (not shown) of the gear selector for a transmission system (emphasis added.)

Accordingly, no new matter is believed to be added.

Objection – Specification

The specification has been objected to as failing to provide proper antecedent basis for the limitations “a lever mounted to said base plate” or “a solenoid mounted to said base plate” as generally recited in independent claims 1, 9 and 23. Applicants respectfully request reconsideration and withdrawal in view of the following comments.

At the outset, Applicants note that the specification need not provide literal support for each claim limitation. See, for example, MPEP § 2106(V)(B)(1) (“For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67, 43 USPQ2d 1398, 1404-05 (Fed. Cir. 1997); *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998). The claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. Software

aspects of inventions, for example, may be described functionally. See *Robotic Vision Sys. v. View Eng'g, Inc.*, 112 F.3d 1163, 1166, 42 USPQ2d 1619, 1622-23 (Fed. Cir. 1997); *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1537-38, 25 USPQ2d 1241, 1248-49 (Fed. Cir. 1992).) (Emphasis added.)

Nevertheless, Applicants note that at least FIGS. 1 and 2 as well as paragraph [0022] of the published application provide literal support for the claimed invention. In particular, Applicants respectfully submit that FIG. 2 clearly describes the solenoid and lever being mounted to the base plate. In addition, paragraph [002] of the specification states, *inter alia*:

Turning to FIG. 1, an exemplary pawl actuator 10 consistent with the present invention is shown in an exploded view. The illustrated actuator generally includes a base plate 12 having a solenoid 14 and latching lever 16 mounted thereon. The latching lever 16 may be pivottally mounted to the base plate 12 by a pin 18, and adapted to follow a detent bracket (not shown) of the gear selector for a transmission system.

Accordingly, Applicants respectfully submit that the objection to the specification may now be withdrawn upon reconsideration of the above comments.

Rejections Under 35 U.S.C. §102

Claims 1, 3, 5, 7, 9, 12, 23, 25, 27 and 28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smale et al. (U.S. Patent No. 5,566,581, hereinafter “Smale”). Applicants respectfully request reconsideration in view of the following comments.

In response to Applicants’ previous argument that Smale is not understood to disclose or suggest a lever and a solenoid mounted to a base plate, the present Office Action states in the *Response to Arguments* section that the term “mounted” as used in independent claims 1, 9 and 23 is being interpreted to mean “to arrange or assemble for use or display” as evidenced by Merriam-Webster’s Collegiate Dictionary, 10th edition. Applicants respectfully submit that this definition is not *reasonable* in view of the specification.

MPEP § 2106 emphasis, *inter alia*, that “USPTO personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum.” Applicants respectfully submit that one of ordinary skill in the art would understand that the term “mounted” as used in the specification and claims of the present

application is clearly intended to denote a structural cooperative relationship between the latch lever, solenoid and the base plate. Applicants note that definition 6a of the verb “mount” according to Merriam-Webster’s Online Dictionary (i.e., the definition *immediately preceding* the one offered in the present Office Action) states that “mount” means “to attach to a support.” Applicants respectfully submit that this later interpretation is consistent with the definition used by the Federal Circuit for the term “mounted” (“the ordinary meaning of ‘mounted on,’ i.e., securely attached, affixed, or fastened to, applies here” *Asyst Technologies, Inc. v. Emtrak, Inc.*, 402 F.3d 1188 (Fed. Cir. 2005).)

In contrast, the definition offered by the present Office Action (i.e., “to arrange or assemble for use or display”) is directed to the concept of displaying an object or the like (e.g., mounting a picture to a wall) which is clearly not what one of ordinary skill in the art would understand the term to mean in the present application. While Applicants appreciate that terms in a claim are to be given the broadest *reasonable* interpretation during prosecution and that limitations from the specification are not to be read into the claims, Applicants respectfully reiterate that the interpretation of a term must be *reasonable* and taken from “the perspective of one of ordinary skill in the art” and “not to be evaluated in a vacuum.”

In view of the above (and in particular the definition of the term “mounted” as used in the present application), Applicants respectfully submit that one of ordinary skill in the art would not understand both the latch bar 34 and solenoid 52 of Smale to be *mounted to* the bracket 46 as suggested in the present Office Action. As discussed in the previous response, the latch bar 34 of Smale is clearly shown and described as being mounted on a shift lever 22 and the solenoid 53 is clearly shown and described as being mounted on a bracket 46. Accordingly, Applicants respectfully submit that Smale is not understood to disclose or suggest all of the limitations recited in independent claim 1, 9 and 23.

In an effort to further prosecution, Applicants have also amended independent claims 1, 9 and 23 to further clarify that the latching lever is pivots mounted to the base plate by a pin and pivotable between at least a first position and a second position. Again, support for these limitations may be found in, at least, paragraph [0022] of the published application which literally describes these limitations. Turning now to Smale, Applicants respectfully submit that

Smale is not understood to disclose or suggest that the latch bar 34 is pivotally mounted to the bracket 46 by a pin.

Accordingly, Applicants respectfully submit that Smale is not understood to disclose or suggest all of the limitations recited in independent claims 1, 9 and 23. As such, Applicants respectfully request that the rejection of independent claims 1, 9 and 23 may now be withdrawn upon reconsideration. The remaining claims depend, either directly or indirectly, from independent claims 1, 9 or 23. Therefore, Applicants respectfully submit that the remaining claims are also allowable by virtue of their dependency from independent claims 1, 9 or 23 in addition to their own patentable limitations.

Rejections Under 35 U.S.C. §103

Dependent claims 2 and 24 have been rejected under 35 U.S.C. §103(a) as being obvious in view of Smale combined with Dörr et al. (U.S. Patent No. 5,379,872, hereinafter “Dorr”). Dependent claims 4, 10 and 26 have been rejected under 35 U.S.C. §103(a) as being obvious in view of Smale combined with Kataumi et al. (U.S. Patent No. 5,421,792, hereinafter “Kataumi”). Lastly, dependent claims 8, 13 and 29 have been rejected under 35 U.S.C. §103(a) as being obvious in view of Smale combined with Mochida (U.S. Patent No. 4,473,141, hereinafter “Mochida”). Applicants respectfully request reconsideration of these rejections.

All of the claims rejected under 35 U.S.C. § 103 depend from independent claims 1, 9 or 23. Applicants respectfully submit that none of the additional references are understood to disclose or suggest the limitations missing from the primary reference, Smale, nor have they even been asserted to provide such teachings. As such, these claims are believed to be allowable over the cited references by virtue of their dependency as well as for their own limitations.

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable over the cited references. A Notice of Allowance is earnestly solicited. No additional fees are believed necessitated by this response. However, in the event of any fee deficiencies, or that additional fees are payable, please charge our Deposit Account No. 50-2121 as necessary.

RESPECTFULLY SUBMITTED,

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